

INTERNATIONAL PRELIMINARY EXAMINATION REPORT
(PCT Article 36 and Rule 70)

Rec'd PCT/PTO 02 MAR 2005



REC'D 28 DEC 2004

WIPO PCT

Applicant's or agent's file reference B020522PC jw		FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/PEA/416)
International application No. PCT/EP 03/10241	International filing date (day/month/year) 15.09.2003	Priority date (day/month/year) 16.09.2002
International Patent Classification (IPC) or both national classification and IPC B01J29/B9		
Applicant BASF AKTIENGESELLSCHAFT et al.		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.
2. This REPORT consists of a total of 6 sheets, including this cover sheet.
 - ☒ This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).
 - These annexes consist of a total of 4 sheets.

3. This report contains indications relating to the following items:
 - I ☒ Basis of the opinion
 - II ☐ Priority
 - III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
 - IV ☐ Lack of unity of invention
 - V ☒ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
 - VI ☐ Certain documents cited
 - VII ☐ Certain defects in the international application
 - VIII ☐ Certain observations on the international application

Date of submission of the demand 10.02.2004	Date of completion of this report 28.12.2004
Name and mailing address of the international preliminary examining authority:  European Patent Office - P.B. 5818 Patentlaan 2 NL-2280 HV Rijswijk - Pays Bas Tel. +31 70 340 - 2040 Tx: 31 651 epo nl Fax: +31 70 340 - 3016	Authorized Officer Schoofs, B Telephone No. +31 70 340-2760 

**INTERNATIONAL PRELIMINARY
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International application No. PCT/EP 03/10241

I. Basis of the report

1. With regard to the **elements** of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17)*):

Description, Pages

1-26 as originally filed

Claims, Numbers

1-18 received on 18.05.2004 with letter of 17.05.2004

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).
☐ the language of publication of the international application (under Rule 48.3(b)).
☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
☐ filed together with the international application in computer readable form.
☐ furnished subsequently to this Authority in written form.
☐ furnished subsequently to this Authority in computer readable form.
☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- ☐ the description, pages:
☐ the claims, Nos.:
☐ the drawings, sheets:

5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

(Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.)

6. Additional observations, if necessary:

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**V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement**

1. Statement

Novelty (N)	Yes: Claims	
	No: Claims	1,16
Inventive step (IS)	Yes: Claims	
	No: Claims	2-15,17-18
Industrial applicability (IA)	Yes: Claims	1-18
	No: Claims	

2. Citations and explanations

see separate sheet

Re Item V

**Reasoned statement with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement**

1. Reference is made to the following document:

D1: WO 02 060580 A (TSUJI JUNPEI ;YAMAMOTO JUN (JP); SUMITOMO
CHEMICAL CO (JP)) 8 August 2002 (2002-08-08) & EP 1 364 705 A
(SUMITOMO CHEMICAL CO) 26 November 2003 (2003-11-26)

For the purpose of this communication, reference is made to EP 1 364 705 A.

2. The amended claims 1 to 18 as filed on 18.05.2004 are considered to be admissible
in terms of Article 34(2)(b) PCT.

- 2.1 Independent claims 1 and 16 as amended now specify that
(1) the solid material is intended "for use as catalytic material in an epoxidation
reaction", and
(2) "the at least one epoxide is the product of said epoxidation reaction".

3. From page 2, lines 18-23 of the description, it appears that the epoxide or
hydrolysate thereof to be used in the present preparation process is 'the same'
epoxide as the product of the epoxidation reaction wherein the solid material is to be
used. In other words, if one intends to produce propylene oxide, one should use
propylene oxide or propylene glycol in the preparation process. If however, one
intends to produce ethylene oxide, one should use ethylene oxide or ethylene glycol
in the preparation process.

- 3.1 However, such an interpretation is not in line with the wording of present claims 1 and
16 for the following reasons:

- 3.1(a) according to the wording of the claims, the solid material can be used in 'any'
epoxidation reaction and hence the epoxide or hydrolysate thereof to be used in
the preparation process can be the product of 'any' such epoxidation process.

As a result, the scope of the claim is not limited to the situation wherein the epoxide or hydrolysate thereof to be used in the preparation process is 'the same' epoxide as the product of the epoxidation reaction wherein the solid material is to be used.

- 3.1(b) If one were to interpret the expression "said epoxidation reaction" as used in claims 1 and 16 in a more restricting way such that 'the epoxide or hydrolysate thereof to be used in the preparation process is the product of the epoxidation reaction wherein the solid material is used', this would lead to a typical chicken and egg-situation since it would be impossible to prepare a catalyst for the first time when this preparation requires the use of a product that is imperatively obtained by using this - not yet existing - catalyst.
- 3.2 In view of the above, the wording of the claims is construed as indicated under paragraph 3.1(a) above.
4. D1 discloses a process for the preparation of a titanium-containing silicon oxide catalyst, in which diols such as ethylene glycol and the like are added as a solvent to the synthesis mixture containing the titanium source (D1, claim 1, example 1, paragraphs 15-26 and in particular paragraph 23).
- 4.1 D1 further discloses that the catalyst is separated from the mother liquor and molded into a shaped body. The catalyst is used in the epoxidation of olefins with hydroperoxides (D1, paragraphs 26-63).
- 4.2 Ethylene glycol is the hydrolysate of an epoxide which is the product of an epoxidation reaction.
- 4.3 The subject-matter of claim 1 is therefore not new (Article 33(2) PCT).
- 4.4 The further product by process features (Ia) to (If) in present claim 16 do not appear to be result in a feature in the resulting solid material that could distinguish it from the solid materials known from D1. The subject-matter of claim 16 is therefore not new (Article 33(2) PCT and PCT Guidelines, 5.26, 5.27 and A5.26).

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- 4.5 Dependent claims 2-15 and 17-18 do not appear to contain any features which, in combination with the features of any claim to which they refer, are associated with any technical effect that could support the presence of an inventive step. Hence, no inventive step is present in the subject-matter of claims 2-15 and 17-18 (Article 33(3) PCT).

Additional comment upon entry into the European phase

5. The expression "incorporated by reference" on page 22, lines 1-2 has to be deleted.
- 5.1 An inventive step has to be established over the whole claimed range, i.e. all epoxides or hydrolysates thereof, all transition metal oxides and all zeolites that come within the scope of the claims.